PATENT
Attorney Docket No.: 018781-007610US
Client Ref. No.: T00-027-1US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Jing Li, Scott Powers, Phil Xiang and Yue Peng Application No.: 10/071,838 Filed: February 8, 2002 For: PRC17: AN AMPLIFIED CANCER GENE Customer No.: 20350	Confirmation No. 1366 Examiner: Susan Ungar Technology Center/Art Unit: 1642 RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Action mailed September 20, 2004, please enter the following response to the restriction requirement. Enclosed herewith is a fee authorization to extend the time for response for one month.

Applicants elect Group 2, claims 1-9, drawn to a method of detecting breast cancer cells in a biological sample comprising detecting a nucleic acid molecule encoding SEQ ID NO:2 or a variant thereof. This election is made with traverse.

According to the MPEP, where claims can be examined together without undue burden, the Examiner must examine the claims on the merits even though they are directed to independent and distinct inventions. See, the MPEP at § 803.01. In establishing that an "undue burden" would exist for co-examination of claims, the Examiner must show that examination of the claims would involve substantially different prior art searches, making the co-examination burdensome. Applicants respectfully submit that a proper search of the claims drawn to detection of cancer by detecting nucleic acid and amino acid sequences relating to SEQ ID NO:2 would not constitute an undue burden, as a proper search would likely encompass both nucleic acid and protein sequences. A proper search would also likely detect art relating to both detecting cancer and monitoring the efficacy of cancer treatment. Applicants therefore request that Groups 1-4, 13-16, 25-28, and 37-40 be examined together.

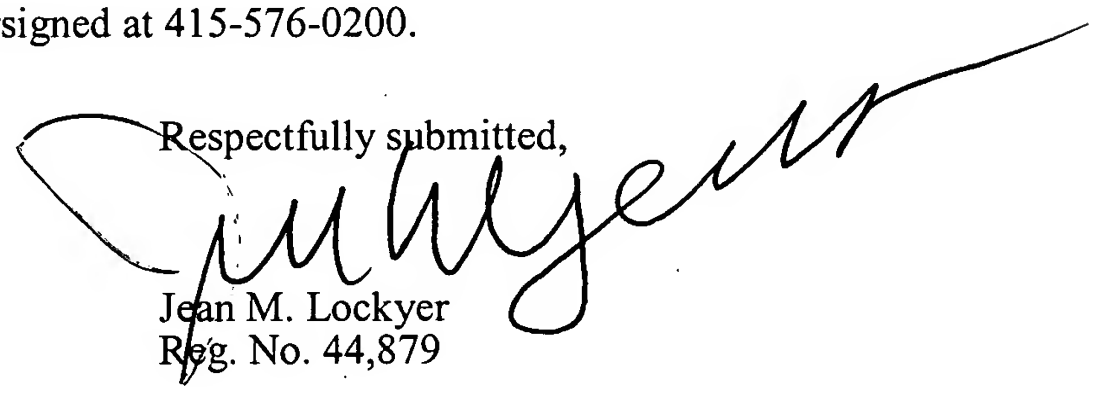
Further, the division of claims 1-9 into four groups based on the type of cancer detected is contrary to MPEP § 803.02, which relates to restriction practice and Markush-type claims (claim 8). There, the MPEP requires that where the members of the Markush groups are sufficiently few in number and examination of the claims can be made without serious burden, the examiner must examine all members together. Even if the Examiner deems that it would require undue burden, then the proper practice is to issue a species election requirement, not a restriction (*see,* procedure detailed in MPEP § 803.02).

The restriction of claim 1-9 into four groups appears to preclude Applicants from being able to obtain claims to more than one species (should the generic claim be deemed not allowable by the Examiner) in the same application--even though those species are determined to be free of the prior art during the examination of the generic claim. This imposes a serious burden on the applicants as it would necessitate the filing of many separate applications. It is also a departure from the typical practice in the chemical art units, where the Patent Office routinely allows claims to issue with multiple species if a generic compound is not found to be allowable.

In view of the foregoing, at a minimum, Applicants respectfully request rejoinder of Groups 1-4.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



Jean M. Lockyer
Reg. No. 44,879

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300

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